

REMARKS

By this Amendment, claims 1, 11, 20, 22, and 39 are amended and claims 59 and 60 are added, leaving claims 2-10, 12-19, 21, 23-38, and 40 unchanged (claims 41-58 were withdrawn from consideration by the Examiner).

On page 2 of the Office Action, the drawings are objected to based upon several reference numerals employed in the present application. The Applicant respectfully requests reconsideration of the drawing objection. In particular, the Applicant notes that throughout the specification of the present application, reference is made to some elements using different names: a generic name referencing an element or structure that can take several forms, and a more specific name referencing one of those forms as illustrated in the drawings. For example, a “conveyor” is employed in some embodiments to move empty disc cases from a magazine 30 (Present Application, page 7, line 30 to page 8, line 2). Although this “conveyor” can take a number of different forms as described in the present application, the illustrated embodiment shows the conveyor as a “piston or solenoid-operated ejector”. Therefore, the reference numeral 24 in the figures correctly refers to the “conveyor” and to the “piston or solenoid-operated ejector”. To require removal of the reference numeral 24 from the term “conveyor” in the specification would suggest that the conveyor is not shown in the figures (although it is). Similarly, to require removal of the reference numeral 24 from the term “piston or solenoid-operated ejector” in the specification would also suggest that this device is not shown in the figures (although it is).

The above discussion regarding the use of two names in conjunction with a common reference numeral applies equally to reference numerals 30, 17, and 60 identified by the Examiner. Accordingly, the Applicants respectfully submit that the specification and drawings of the present application are in proper form and should not be changed, and request withdrawal of the drawing objections.

Also on page 2 of the Office Action, claim 11 is rejected due to an informality. Claim 11 is hereby amended to address this objection. Accordingly, the Applicant respectfully requests withdrawal of the objection to claim 11.

On pages 3 and 4 of the Office Action, claims 1-3, 7-16, 18, 20-22, 26-35, 37, 39, and 40 are rejected under 35 U.S.C. §103(a) as being unpatentable over United State Patent Number 6,536,194 issued to Minardi in view of United States Patent Number 6,527,500 issued to Gelardi and United States Patent Number 5,664,405 issued to Perego.

Claim 1 of the present application is hereby amended, and calls for:

“An apparatus for packaging a media disc into a case, the case having a housing to which a lid is coupled for movement between an open and a closed position, the apparatus comprising:

...
an inclined surface positioned to contact and generate initial separation between the lid and the housing of the case. . . by relative movement between the conveyor and the inclined surface . . .”

(Amendment marks not shown; underlining added for emphasis).

As discussed in greater detail in the present application, some embodiments of the present invention have an inclined surface that causes the disc case to open. For example, the disc case in some embodiments can be separated by contacting and moving the disc case relative to the inclined surface. This contact and relative movement between the case and the inclined surface causes the initial separation of the lid from the housing of the case as well as further opening of the case. Also, this contact and relative movement between the case and the inclined surface can be generated by moving the case toward the inclined surface and/or by moving the inclined surface toward the case as described in greater detail in the present application as originally filed. Claim 1 calls for an inclined surface to cause the initial separation of the lid from the housing.

In contrast, neither Minardi, Gelardi, nor Perego teach an inclined surface causing the initial separation between the lid and housing of the case. As discussed with the Examiner in the Examiner's Interview with the undersigned Applicant's Representative on October 10, 2003, Minardi does disclose a trapezoidal-shaped "contrast means" 18 (see Minardi, column 3, lines 39-46 and figures 9-11). In the interview, the Examiner noted that either angled edge of the contrast means 18 (not numbered, but best shown in FIGS. 9-11 of Minardi) can be compared to the inclined surface claimed in claim 1. However, neither angled edge of the contrast means 18 of the Minardi apparatus "contact[s] and generate[s] initial separation between the lid and the housing" as claimed in amended claim 1. Rather, the Minardi apparatus inserts a non-inclined rectangular protuberance 118 into a similarly shaped recess R in the case. This non-inclined rectangular protuberance 118 is then rotated ninety degrees in a later step to generate initial separation of the lid from the housing. Thus, it is the rotation of the non-inclined rectangular protuberance 118 that generates initial separation of the case in the Minardi device – not the angled edges of the contrast means 18 or any other "inclined surface" as claimed in amended claim 1. Indeed, the angled edges of the contrast means 18 do not appear to even contact the case until after the case has been separated.

Neither Gelardi nor Perego teach, describe or suggest the use of an inclined surface to contact and generate initial separation between the lid and the housing of a case. Accordingly, neither Gelardi nor Perego address the deficiencies of Minardi described above.

For these and other reasons not discussed herein, the Applicant respectfully submits that amended claim 1 is novel and patentable over Minardi, Gelardi, Perego, and their combined teachings, and requests withdrawal of the rejection of claim 1 in light of these references.

Claims 2-19 are each ultimately dependent from amended claim 1, and are believed to be allowable based upon amended claim 1 and upon other features and limitations claimed in claims 2-19 but not discussed herein.

Claim 20 of the present application is also hereby amended, and calls for:

“An apparatus for packaging a media disc into a case, the case having a housing to which a lid is coupled for movement between an open and a closed position, the apparatus comprising:

...

an inclined surface positioned to contact and open the case by a single continuous relative motion between the case and the inclined surface, the single continuous relative motion generating initial contact between the inclined surface and the case and separation between the lid and the housing of the case. . . .”

(Amendment marks not shown; underlining added for emphasis).

As discussed in greater detail in the present application, some embodiments of the present invention have an inclined surface that causes a disc case to open by a single continuous relative motion between the case and the inclined surface, wherein this motion generates initial contact between the inclined surface and the case as well as separation between the lid and the housing of the case.

The arguments presented above regarding claim 1 apply equally to claim 20. Neither Minardi, Gelardi, nor Perego teach the use of an inclined surface causing separation between the lid and housing of a case. Reference is hereby made to the discussion above regarding claim 1 for complete remarks in this regard.

In addition, neither Minardi, Gelardi, nor Perego teach the use of an inclined surface in combination with a single continuous relative movement between a case and the inclined surface to cause separation between the lid and housing. Minardi instead employs a number of motions and steps to separate and open the case. As shown in FIG. 3 of Minardi, the contrast means 18 of the Minardi apparatus requires at least three motions (and two different types of motion) to separate cases: a linear motion to insert the protuberance 118 into the recess R of the case as shown in FIG. 3, a rotational motion of the protuberance 118 about the axis of the stem 19 to

separate the case as shown in FIG. 9, and another linear motion to open the case as shown in FIGS. 10 and 11.

As described above, neither Gelardi nor Perego teach, describe or suggest the use of an inclined surface to contact and separate the lid and the housing of a case. Also, neither Gelardi nor Perego teach the use of an inclined surface in combination with a single continuous relative movement between a case and the inclined surface to cause separation between the lid and housing. Accordingly, neither Gelardi nor Perego address the deficiencies of Minardi described above.

For these and other reasons not discussed herein, the Applicant respectfully submits that amended claim 20 is novel and patentable over Minardi, Gelardi, Perego, and their combined teachings, and requests withdrawal of the rejection of claim 20 in light of these references.

Claims 21-38 are each ultimately dependent from amended claim 20, and are believed to be allowable based upon amended claim 20 and upon other features and limitations claimed in claims 21-38 but not discussed herein.

Claim 39 of the present application is also hereby amended, and calls for:

“An apparatus for opening a media disc case, the case having a housing to which a lid is coupled for movement between an open and a closed position, the apparatus comprising:

...

an inclined surface positioned to contact the case, generate initial separation between the lid and the housing of the case, and open the case on the conveyor all by a single type of continuous relative movement between the conveyor and the inclined surface . . .”

(Amendment marks not shown; underlining added for emphasis).

As discussed in greater detail in the present application, some embodiments of the present invention have an inclined surface that contacts the disc case, generates initial separation between the lid and the housing of the case, and open the case by a single type of continuous relative movement between the conveyor and the inclined surface.

The arguments presented above regarding claim 1 apply equally to claim 39. Neither Minardi, Gelardi, nor Perego teach the use of an inclined surface causing initial separation between the lid and housing of a case. Reference is hereby made to the discussion above regarding claim 1 for complete remarks in this regard.

In addition, neither Minardi, Gelardi, nor Perego teach the use of an inclined surface that contacts a case, generates initial separation between the lid and housing of the case, and opens the case all by a single type of continuous relative movement (whether between a conveyor and the inclined surface or otherwise). Minardi instead employs at least two different types of movement to separate cases: a linear type of movement to insert the protuberance 118 into the recess R of the case as shown in FIG. 3, a rotational movement of the protuberance 118 about the axis of the stem 19 to separate the case as shown in FIG. 9, and another linear movement to open the case as shown in FIGS. 10 and 11.

As described above, neither Gelardi nor Perego teach, describe or suggest the use of an inclined surface to contact and separate the lid and the housing of a case. Also, neither Gelardi nor Perego teach the use of an inclined surface that contacts a case, generates initial separation between the lid and housing of the case, and opens the case all by a single type of continuous relative movement. Accordingly, neither Gelardi nor Perego address the deficiencies of Minardi described above.

For these and other reasons not discussed herein, the Applicant respectfully submits that amended claim 39 is novel and patentable over Minardi, Gelardi, Perego, and their combined teachings, and requests withdrawal of the rejection of claim 39 in light of these references.

Claim 40 is dependent from amended claim 39, and is believed to be allowable based upon amended claim 39 and upon the additional limitation claimed in claims 40 but not discussed herein.

Claims 59 and 60 are hereby added to more fully claim that which the Applicant regards as the invention.

In view of the amendments and remarks presented herein, it is respectfully submitted that the claims as amended are in condition for allowance, and notification to that effect is respectfully requested. The Applicant kindly requests that the Examiner telephone the attorney of record in the event a telephone discussion would be helpful in advancing the prosecution of the present application.

Respectfully submitted,



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